

ESTTA Tracking number: **ESTTA532908**

Filing date: **04/17/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Blue Cross and Blue Shield Association
Granted to Date of previous extension	04/17/2013
Address	225 North Michigan Avenue Chicago, IL 60601 UNITED STATES

Attorney information	Garner K. Weng Hanson Bridgett LLP 425 Market Street, 26th Floor San Francisco, CA 94105 UNITED STATES ttabfilings@hansonbridgett.com, gweng@hansonbridgett.com, sonellttabfilings@hansonbridgett.com, mstrattonttabfilings@hansonbridgett.com Phone:415-777-3200
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Applicant Information

Application No	85643431	Publication date	12/18/2012
Opposition Filing Date	04/17/2013	Opposition Period Ends	04/17/2013
Applicant	Jerry R. Carnahan Insurance Agency, Inc. Ste. 101 601 Embassy Oaks San Antonio, TX 78216 UNITED STATES		


Goods/Services Affected by Opposition


Class 036. First Use: 2011/10/00 First Use In Commerce: 2012/02/00 All goods and services in the class are opposed, namely: Insurance risk management; Insurance risk management consultation
Class 041. First Use: 2011/10/00 First Use In Commerce: 2012/02/00 All goods and services in the class are opposed, namely: Educational services, namely, providing workshops, seminars, coaching, and training in the field of insurance risk management, namely, teaching business owners how to make their business safer from losses and claims and to increase the overall productivity

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

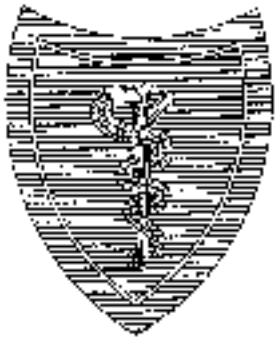
Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	557037	Application Date	12/15/1949
Registration Date	04/01/1952	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1939/09/23 First Use In Commerce: 1940/04/00 FURNISHING MEDICAL CARE ON A PRE-PAYMENT BASIS		


U.S. Registration No.	557040	Application Date	11/13/1950
Registration Date	04/01/1952	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U102 (International Class 036). First use: First Use: 1939/09/23 First Use In Commerce: 1940/04/00 UNDERWRITING THE EXPENSE OF MEDICAL CARE		


U.S. Registration No.	562430	Application Date	07/16/1951
Registration Date	07/29/1952	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U102 (International Class 036). First use: First Use: 1949/09/05 First Use In Commerce: 1949/09/05 UNDERWRITING, ON A PREPAYMENT BASIS, THE EXPENSE TO THE PATIENT OF MEDICAL CARE AND UNDERWRITING THE DOCTOR'S EXPENSE IN FURNISHING MEDICAL CARE


U.S. Registration No.	591778	Application Date	10/06/1952
Registration Date	06/22/1954	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U102 (International Class 036). First use: First Use: 1947/10/00 First Use In Commerce: 1947/10/00 UNDERWRITING, ON A PREPAYMENT BASIS, THE EXPENSE TO THE PATIENT OF MEDICAL CARE AND UNDERWRITING THE DOCTOR'S EXPENSE IN FURNISHING MEDICAL CARE		

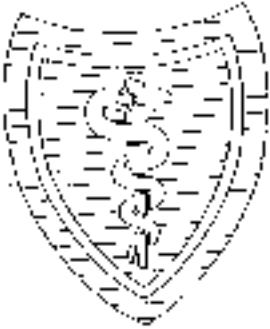
U.S. Registration No.	617304	Application Date	07/21/1954
Registration Date	12/06/1955	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U102 (International Class 036). First use: First Use: 1947/10/00 First Use In Commerce: 1947/10/00 UNDERWRITING, ON A PREPAYMENT BASIS, THE EXPENSE TO THE PATIENT OF MEDICAL CARE AND UNDERWRITING THE DOCTOR'S EXPENSE IN FURNISHING MEDICAL CARE


U.S. Registration No.	1514572	Application Date	04/04/1988
Registration Date	11/29/1988	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1973/07/24 First Use In Commerce: 1973/07/24 EDUCATIONAL BOOKS, BINDERS, PRINTED FORMS, BUSINESS FORMS, TRADE JOURNALS, NOTEBOOKS, WRITING PAPER, ENVELOPES, PENS AND PENCILS		


U.S. Registration No.	1735461	Application Date	07/22/1991
Registration Date	11/24/1992	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1988/06/28 First Use In Commerce: 1988/06/28 health care services rendered through a health maintenance organization; namely, physician services, dental services, hospital services, home health care services, preventative health care services, health care services, medical lab services, counseling services in the field of family planning, mental health services and pharmacy services

U.S. Registration No.	2202586	Application Date	04/01/1997
Registration Date	11/10/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1996/10/00 First Use In Commerce: 1996/10/00 insurance, namely, underwriting in the field of workers compensation with or without a managed care component		

U.S. Registration No.	2634534	Application Date	05/03/2001
Registration Date	10/15/2002	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark is used in the color blue
Goods/Services	Class 016. First use: First Use: 1939/09/23 First Use In Commerce: 1949/11/05 newsletters pertaining to health and insurance

U.S. Registration No.	3255615	Application Date	05/10/2006
Registration Date	06/26/2007	Foreign Priority Date	NONE
Word Mark	WALKING WORKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/05/15 First Use In Commerce: 2005/05/15 Educational services, namely conducting classes and seminars in the fields of health, fitness, diet and lifestyle choices; entertainment services, namely organizing and conducting walking events to increase the awareness of physical fitness		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	A family of BLUE and BLUE-formative marks, including BLUE SHIELD marks, and marks consisting of or including an image of a shield design (registered and at common law), as further described in the Notice of Opposition.		
Goods/Services	A range of goods and services relating to health care, health care plans, and insurance, as further described in the Notice of Opposition.		

Attachments	71589371#TMSN.gif (1 page)(bytes) 71606403#TMSN.gif (1 page)(bytes)
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	71616543#TMSN.gif (1 page)(bytes) 71636199#TMSN.gif (1 page)(bytes) 71670326#TMSN.gif (1 page)(bytes) 73720589#TMSN.gif (1 page)(bytes) 74187011#TMSN.gif (1 page)(bytes) 75267653#TMSN.gif (1 page)(bytes) 76250527#TMSN.gif (1 page)(bytes) 78880311#TMSN.jpeg (1 page)(bytes) Notice of Opposition to Serial No 85643431 owned by Carnahan Insurance.pdf (10 pages)(27585 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Garner K. Weng/
Name	Garner K. Weng
Date	04/17/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: APPLICATION SERIAL NO. 85/643,431

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

JERRY R. CARNAHAN INSURANCE
AGENCY, INC.,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer Blue Cross and Blue Shield Association, a not-for-profit membership-based corporation organized and existing under the laws of the State of Illinois, doing business at 225 North Michigan Avenue, Chicago, IL 60601-7680, brings this Opposition against Application Serial No. 85/643,431, filed by Jerry R. Carnahan Insurance Agency, Inc., having an address of 601 Embassy Oaks, Ste. 101, San Antonio, Texas 78216.

1. On information and belief, on June 5, 2012, Jerry R. Carnahan Insurance Agency, Inc. ("Applicant") filed Application Serial No. 85/643,431 (the "Application") under Section 1(a) of the Lanham Act. On information and belief, the Application was published in the U.S. Patent & Trademark Office's *Official Gazette* on December 18, 2012. The Application on its face seeks to cover: "Insurance risk management; Insurance risk management consultation" in International Class 36; and "educational services, namely, providing workshops, seminars, coaching, and training in the field of insurance risk management, namely, teaching business owners how to make their business safer from losses and claims and to increase the overall productivity" in International Class 41. The Application describes the subject mark ("Applicant's Mark") as

including a "shield in various shades of blue." The design codes assigned to Applicant's Mark include those for "[s]hields or crests with letters, punctuation or inscriptions contained therein or superimposed thereon." In sum, Applicant's Mark specifically describes a blue shield and, in practice, Applicant uses the subject shield design in the color blue.

2. Opposer Blue Cross and Blue Shield Association (the "Association") is a national association of 38 independent, community-based, and locally operated BLUE CROSS® and BLUE SHIELD® companies ("Member Plans"). The Association represents the nation's oldest and largest family of health benefits companies. For over 80 years, the Association (including through its predecessors in interest and its Member Plans and licensees) has provided tens of millions of families with top-quality affordable health care plans. The Association's Member Plans currently provide health care plans for just over 100 million people in the United States—or about 1 in 3 Americans—and offer health care plans in all 50 states, the District of Columbia, and in Puerto Rico. More than 90% of hospitals and 80% of physicians in the United States contract with the Association's Member Plans—more than any other insurer. The Association's Member Plans currently provide health care plans to more than 75% of the Fortune 500 companies and more than 80% of the Fortune 100 companies.

3. The BLUE CROSS and BLUE SHIELD brands are among the most recognized in the health and health-related industries in the United States—and, indeed, in any industry. The Association is the owner of the BLUE SHIELD design marks—as well as the BLUE SHIELD word mark, the BLUE CROSS word and design marks, and other marks consisting of the image of a blue shield or the image of a blue cross (or both)—and licenses the use of various such marks to its Member Plans and other licensees for the provision of a wide variety of goods and services, including but not limited to health insurance, life insurance, dental insurance, vision insurance, disability insurance, long-term care insurance, workers' compensation insurance, health care delivery services, financial services, wellness services, health education, and other related goods and services. The Association (including through its predecessors in interest and

its Member Plans and licensees) has been using these trademarks and service marks since at least as early as 1934 (BLUE CROSS) and 1939 (BLUE SHIELD).

4. In the United States alone, the Association currently owns approximately 240 valid and subsisting U.S. federal trademark and service mark registrations. Many of its U.S. federal registrations have become incontestable under Section 15 of the Lanham Act. Additionally, the Association owns similar trademark and service mark registrations in more than 170 countries throughout the world. All these (along with numerous trade names and common-law marks) form a “family” of BLUE trade names, trademarks, and service marks (“Blue Marks”). Under the Lanham Act, the Association’s incontestable U.S. federal registrations are conclusive evidence of the Association’s exclusive right to use or authorize the use of the Blue Marks in commerce.

5. The Association (including through its Member Plans and licensees) has extensively used, advertised, and promoted the Blue Marks throughout the United States. For instance, in past years annual gross revenue under the Blue Marks has been on the order of \$360 billion. The Association (including through its Member Plans and licensees) spends millions of dollars in advertising and promoting its marks, services, products, and image, thereby creating substantial goodwill in the marketplace. As a result, the general public recognizes the Blue Marks separately and collectively as identifying the Association and its Member Plans and licensees—and the quality services they render. The Blue Marks are an asset of incalculable value to the Association and it has vigorously and successfully protected its marks. Moreover, at least as far back as 1977, federal district courts and other legal panels such as the World Intellectual Property Organization Uniform Dispute Resolution Policy Panel have expressly recognized the fame of the Blue Marks in the context of trademark disputes or litigation. In sum, the Blue Marks have long been famous, and were famous long before Applicant’s adoption, use of, or application to register Applicant’s Mark.

6. Among the Association's Blue Marks are a wide range of marks consisting entirely or substantially of the words BLUE SHIELD or an image of a blue shield (or some combination of these) (the "Blue Shield Marks"). Historically and through the present, these Blue Shield Marks span a variety of differently configured shields. The Association (including through its predecessors in interest and its Member Plans and licensees) has used and does use the Blue Shield Marks in a wide range of blue colors, from light to dark and through a variety of hues and tones. Further, the Association (including through its predecessors in interest and its Member Plans and licensees) has used and does use the Blue Shield Marks with an internal design element consisting of an inner outline of the shield that gives the appearance of a border.

7. Several of the Association's U.S. federal trademark registrations for its Blue Marks and Blue Shield Marks are listed in Exhibit A hereto or identified as "Marks Cited by Opposer as Basis for Opposition" in Opposer's electronic submission of this Opposition, and are asserted as the basis for this opposition. As further basis for this opposition, the Association asserts its common law rights in marks consisting of or including an image of a shield design as shown in any of Opposer's registrations referenced above and and/or marks consisting of or including the words BLUE SHIELD in connection with a broad range of insurance, health, medical, and related services. These include without limitation health insurance, life insurance, dental insurance, vision insurance, disability insurance, long-term care insurance, workers' compensation insurance, health care delivery services, wellness services, health education and related educational materials, health and wellness risk assessment, seminars, financial services, and related goods and services.

8. The Blue Marks and the Blue Shield Marks have long been famous and were famous long before Applicant's adoption or use of or application to register Applicant's Mark.

9. Applicant's Mark is confusingly similar to one or more of the Association's Blue Shield Marks. Among other things, Applicant's Mark includes a blue shield with a similar shape

to the Association's Blue Shield Marks. This shield element of Applicant's Mark is prominently placed at the center of Applicant's Mark and visually dominates it. Overall, Applicant's Mark creates a confusingly similar commercial impression to the Association's Blue Shield Marks. Further, the services listed in the Application are similar to, overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those goods and services designated by the Association's Blue Shield Marks; and the goods and services actually provided by Applicant, which include insurance risk management and insurance risk management education and consulting, are similar to, overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those goods and services designated by the Association's Blue Shield Marks. Applicant's Mark is therefore likely to confuse, cause mistake among, or deceive the relevant public into believing that Applicant is sponsored by, endorsed by, or in some manner related to the Association (or its Member Plans or licensees).

10. On information and belief, Applicant selected its mark in the Application, began using this mark, and continues to use this mark with full knowledge of the Association's Blue Shield Marks and with the intent to confuse, cause mistake among, and deceive the public into believing that Applicant's services are of the same high quality as or are in some way associated with the services of the Association (or its Member Plans or licensees).

11. The above-described registration and use of Applicant's Mark is likely to impair and has impaired the distinctiveness of the Blue Marks, and in particular the Blue Shield Marks. This weakens the ability of such marks to identify and distinguish the goods and services of the Association from Applicant and others.

12. Likewise, registration of Applicant's Mark, as described in the Application, will injure the Association by causing the relevant public to be confused, mistaken, or deceived to the detriment of the Association, by diluting the distinctive quality of the Association's famous

Blue Shield Marks, and by harming the reputation of the Association and its marks by associating them with Applicant.

13. For the reasons set forth in this Notice of Opposition, the Association believes that it will be damaged by the registration of Applicant's Mark in the Application. Accordingly, the Association requests and prays that the Application (and all parts of it) be denied registration.

14. In the alternative, should the Board find that the Application is entitled to registration in some form, under Section 18 of the Lanham Act, the Association requests that the Application be allowed registration only with the Application amended so that it claims color as a feature of the mark, with an amended drawing showing the mark in color, with the colors claimed and shown not being or including the color blue.

The Association (through its counsel) hereby authorizes the requisite filing fee in the amount of \$600 to be charged to Hanson Bridgett LLP's U.S. Patent & Trademark Office Deposit Account No. 08-0630; and the Commissioner is further authorized to charge any deficiencies or other amounts due in connection with this filing to Deposit Account No. 08-0630.

Respectfully submitted,

BLUE CROSS AND BLUE SHIELD ASSOCIATION

By /s/ Garner K. Weng
Susan G. O'Neill, Esq.
Garner K. Weng, Esq.
Matthew A. Stratton, Esq.

Attorneys for Opposer
Blue Cross and Blue Shield Association

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Date: April 17, 2013

EXHIBIT A

EXHIBIT A

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
BLUE SHIELD	557,037	IC 42
BLUE SHIELD	557,040	IC 36
Blue Shield Design	562,430	IC 36
Blue Shield Design	591,778	IC 36
Blue Shield Design	617,304	IC 36
Blue Shield Design	1,039,866	IC 36
BLUE SHIELD	1,045,586	IC 36
BLUE SHIELD	1,319,824	IC 36
Blue Shield Design	1,423,379	IC 42
BLUE SHIELD	1,439,564	IC 42
Blue Shield Design	1,514,572	IC 16
Blue Shield Design	1,735,461	IC 42
BLUE CROSS AND BLUE SHIELD ASSOCIATION	1,744,958	IC 42
Blue Shield Design	1,912,003	IC 42
Blue Shield Design	1,997,329	IC 36
BLUE SHIELD	2,016,013	IC 36
BLUE CROSS AND BLUE SHIELD ASSOCIATION	2,150,555	IC 36 IC 42
BLUE CROSS AND BLUE SHIELD ASSOCIATION	2,161,616	IC 16
Blue Shield Design	2,202,586	IC 36
Blue Shield Design	2,634,534	IC 16
BLUE SHIELD	3,076,808	IC 25
BLUE SHIELD	3,076,809	IC 16
BLUE SHIELD	3,076,812	IC 21
Blue Shield Design	3,132,423	IC 25
Blue Shield Design	3,132,425	IC 18
Blue Shield Design	3,132,571	IC 21

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
Blue Shield Design	3,132,573	IC 16
BLUE SHIELD	3,136,687	IC 36
BLUE SHIELD	3,169,932	IC 36
Blue Shield Design	3,172,397	IC 36
WALKING WORKS	3,255,615	IC 41
Blue Shield Design	3,288,739	IC 36
BLUECROSS BLUESHIELD ASSOCIATION AN ASSOCIATION OF INDEPENDENT BLUE CROSS AND BLUE SHIELD PLANS LEADING THE FUTURE OF HEALTHCARE & Design	3,709,586	IC 36 IC 44
MY BLUE COMMUNITY	4,053,700	IC 38 IC 42
BLUE	4,074,287	IC 44

CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 85/643,431 was served on the parties listed below by mailing said copies on April 17, 2013 via U.S. First Class Mail, postage pre-paid to:

Applicant's Attorney/Correspondent of Record:

Jerry R. Carnahan Insurance Agency, Inc.
601 Embassy Oaks, Ste. 101
San Antonio, TX 78216

Dated: April 17, 2013

/s/ Laura Prongos

Laura Prongos